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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/025,777      | 12/26/2001  | Hiroshi Isono        | 07057.0021          | 5900             |

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| EXAMINER |
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SCHWARTZ, CHRISTOPHER P

| ART UNIT | PAPER NUMBER |
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3683

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/025,777

Applicant(s)  
Isono et al

Examiner  
Schwartz

Art Unit  
3683



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 15, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 11, 12, and 16-22 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 8-10, and 13-15 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152) \_\_\_\_\_
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2, 12 6) ☐ Other: \_\_\_\_\_

CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER

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## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 10/30/03 has been received and considered.

### ***Drawings***

2. The drawing correction to figure 8 filed with the amendment of 10/15/03 was received and approved by the examiner.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The changed limitation from “inhibiting” to “preventing” flow between the chamber and the working source in several of the claims was not found in the specification.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-11,17,18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Regarding claims 2,7,17,18 as amended, it is unclear how the first fill device, best understood from applicant's specification to be element(s) 52, "prevents" flow of fluid from the first chamber 46 to the working fluid source 54. As best seen in figures 1, 5 and 13 it appears at most device 52 can only inhibit the flow, not prevent it.

It appears the change from "inhibiting" to "preventing" with respect to the fill device in these claims may be considered to be new matter. Applicant should double check the amendment against the different embodiments in the specification and respond accordingly.

6. The following rejections are subject to the 112 first paragraph above.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,2,7,12,16,19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by

Isono et al. '882.

Regarding claims 1,16 as broadly claimed, Isono et al. '882 still meets the claimed requirements in figure 2. The references have been interpreted differently in light of applicant's amendments to the claims.

Note the fluid pressure cylinder 64 having a front pressurizing chamber 88 which is pressurized by piston 80; a brake comprising a brake cylinder connected to the front chamber; a

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working fluid source 120; and a flow control device 258,260,264, 278,282 etc. capable of preventing the flow of fluid from the chamber to the source if “a fluid pressure in the chamber is unusual relative to an operation of the piston”, as broadly claimed..

Regarding claim 2 note the first fill device can be either of solenoid operated valves 258 and 260 and the first fill selecting device, as broadly claimed, the controller which controls the opening and closing (i.e. enable/disable condition) of these valves. Note the pressurizing chamber is 88 and the working fluid source can be either of elements 120 or 182.

Regarding claim 12 note in figure 19 the “pilot valve” at 436 as broadly claimed.

Regarding claim 19, as broadly claimed, these requirements are met.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 3-4,7,11,17,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isono et al. '882 in view of Isono et al. '881.

Regarding claim 3 Isono et al. '882 also discloses a first fill device in figure 2 at 278 and 280 (acting as an inhibiting device) but lacks showing a first fill selecting device operating in the manner claimed..

Isono et al. '881 is relied upon to provide this teaching at 262 in figure 15. Note the first fill device may be interpreted as solenoid operated valve 262 and 76 in this reference.

One having ordinary skill in the art at the time of the invention would have found it obvious to have placed a valve 262 taught by '881 in parallel with the first fill device 278,280 in '882 dependent upon the particular braking characteristics desired from the system of '882.

Regarding claim 4 these requirements are met.

Regarding claim 7 these requirements are met, as broadly claimed by the combination above.

Regarding claim 11, dependent upon the characteristics desired from the system of '882, as modified, the flow inhibiting device could function as claimed.

Regarding claims 17-18 these requirements are met.

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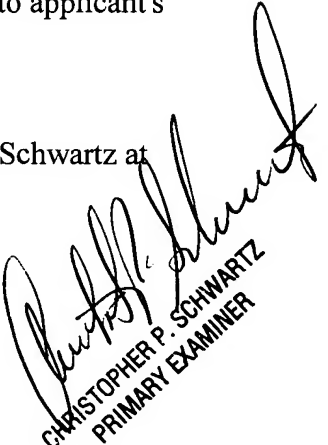
*Allowable Subject Matter*

11. Claims 5,6,8-10,13-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication should be directed to Chris Schwartz at telephone number 703-308-0576.

  
CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER